



ATTORNEY'S DOCKET NUMBER: 2003080-0071 (SK-744-CON4)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Danishefsky *et al.* Examiner: Solola, T. A.  
Serial No.: 10/004,571 Art Unit: 1626  
Filed: December 4, 2001  
For: *Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses Thereof*

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION TO CORRECT FILING RECEIPT**

Applicant respectfully requests that the Filing Receipt be corrected to reflect the following:


- 1) The name of inventor Dongfang Meng as it appears on the Filing Receipt is incorrect. The inventor's name should read as follows:

**Dongfang Meng**

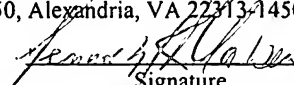
Applicant encloses a copy of the Utility Patent Application Transmittal and Preliminary Amendment filed with the application, both of which note the correct spelling of Meng's name. Also, enclosed is a copy of the Filing Receipt with the inventor's corrected name noted.

Our understanding is that there are no fees associated with this Petition. However, if we are mistaken, please charge any fees that may be associated with this request to our Deposit Account No. 03-1721.

Respectfully submitted,

  
C. Hunter Baker, M.D., Ph.D.  
Registration Number: 46,533

Choate, Hall & Stewart  
Exchange Place  
53 State Street  
Boston, MA 02109  
Tel: (617) 248-5000  
Date: January 26, 2005

<b>Certificate of Mailing</b>	
I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
January 26, 2005	
Date	Signature
Kenneth R. Maben	
Typed or Printed Name of person signing certificate	



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

B147CHB

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/004,571	12/04/2001	1626	3063	2003080-0071 <i>Memorial</i>	59	59	25

24280  
 Choate, Hall & Stewart  
 Exchange Place  
 53 State Street  
 Boston, MA 02109

CONFIRMATION NO. 6609  
 UPDATED FILING RECEIPT  
 \*OC000000014225553\*  
 \*OC000000014225553\*

Date Mailed: 10/28/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

**Applicant(s)**

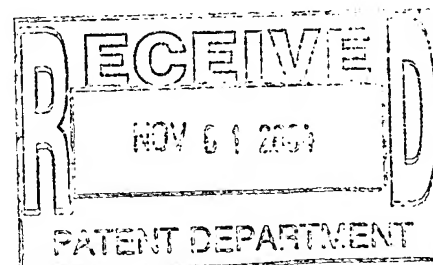
Samuel J. Danishefsky, Englewood, NJ;  
 Peter Bertinato, Old Lyme, CT;  
 Dai-Shi Su, New York, NY;  
 Dang Fang Meng, New York, NY;  
 Ting-Chao Chou, Paramus, NJ;  
 Ted Kamenecka, New York, NY;  
 Erik J. Sorensen, San Diego, CA;  
 Aaron Balog, New York, NY;  
 Kenneth A. Savin, New York, NY;

**Power of Attorney:**

Karoline Shair-44332

**Domestic Priority data as claimed by applicant**

This application is a CON of 09/874,514 06/05/2001  
 which is a CON of 08/986,025 12/03/1997 PAT 6,242,469  
 which claims benefit of 60/032,282 12/03/1996  
 and claims benefit of 60/033,767 01/14/1997  
 and claims benefit of 60/047,566 05/22/1997  
 and claims benefit of 60/047,941 05/29/1997  
 and claims benefit of 60/055,533 08/13/1997

**Foreign Applications**

If Required, Foreign Filing License Granted: 03/18/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/004,571**

Projected Publication Date: 02/03/2005

Non-Publication Request: No

Early Publication Request: No

**\*\* SMALL ENTITY \*\***

Title

Synthesis of epothilones, intermediates thereto, analogues and uses thereof

Preliminary Class

549

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**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy

order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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Serial No.: 10/004,571 Art Unit: 1626  
Filed: December 4, 2001  
For: *Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses Thereof*

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:


**TRANSMITTAL**

Enclosed please find the following:

1. Petition to Correct Filing Receipt (1 page);
2. Copy of Utility Patent Application Transmittal (5 pages);
3. Copy of Preliminary Amendment filed December 4, 2001 (11 pages);
4. Copy of Filing Receipt with correction noted thereon in red ink (3 pages); and
5. Return Postcard.

Applicant believes no fees are required for the filing of the documents listed above. If, however, fees are required, please charge said fees to our Deposit Account No. 03-1721.

Respectfully submitted,

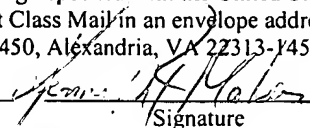
  
C. Hunter Baker, M.D., Ph.D.  
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January 26, 2005  
Date

  
Signature

Kenneth R. Maben

Typed or Printed Name of person signing certificate



# CHOATE, HALL & STEWART

A PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

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BOX PATENT APPLICATION  
ASSISTANT COMMISSIONER FOR PATENTS  
P.O. BOX 2327  
ARLINGTON, VA 22202

**Express Mail No.: EL603009481US**  
**Attorney Docket No.: 2003080-0071**  
**Date Filed: December 4, 2001**

## **UTILITY PATENT APPLICATION TRANSMITTAL**

(for new nonprovisional applications under 37 C.F.R. § 1.53(b))

Dear Sir:

Please find enclosed a patent application and papers as follows for:

### **Inventor(s):**

<b><u>Given Name (first and middle)</u></b>	<b><u>Family Name or Surname</u></b>	<b><u>Residence (City and State or Foreign Country)</u></b>
Samuel J.	Danishefsky	Englewood, NJ
Peter	Bertinato	Old Lyme, CT
Dai-Shi	Su	New York, NY
Dongfang	Meng	New York, NY
Ting-Chao	Chou	Paramus, NJ
Ted	Kamenecka	New York, NY
Erik J.	Sorensen	San Diego, CA
Aaron	Balog	New York, NY
Kenneth A.	Savin	New York, NY

**Title of the Invention: Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses Thereof**

### **A) APPLICATION ELEMENTS:**

- 1) ☒ **Fee Transmittal Form** (original and duplicate submitted for fee processing)
- 2) ☒ **Applicant Claims Small Entity Status** (see 37 C.F.R. § 1.27)
  - a) ☒ **Statement Verifying Small Entity Status** (optional)

3) ☒ **Specification**

TOTAL PAGES: 112

(87 pp. description; 24 pp. claims; 1 pg. abstract)

- ☒ Descriptive Title of the Invention
- ☒ Cross References to Related Applications (if applicable)
- ☒ Statement Regarding Federally Sponsored R & D (if applicable)
- ☐ Reference to sequence listing, a table, or a computer program listing appendix
- ☒ Background of the Invention
- ☒ Summary of the Invention
- ☒ Description of the Drawing (if filed)
- ☒ Detailed Description of the Invention
- ☒ Claim(s)
- ☒ Abstract of the Invention

4) ☒ **Drawing(s)** (35 U.S.C. § 113)

TOTAL SHEETS: 59

- a) ☒ Formal Drawings (if checked)

TOTAL SHEETS: 76

5) ☒ **Oath or Declaration**

TOTAL PAGES: 8

- a) ☐ Newly Executed (original or copy)

- b) ☒ Copy from a prior application (37 C.F.R. § 1.63(d))-for  
continuation/divisional application

- i) ☐ Deletion of inventor(s): Signed Statement deleting inventor(s) named  
in the prior application, see 37 C.F.R. §§ 1.63(d)(2) and 1.33(b).

- c) ☐ Unexecuted

6) ☐ **Application Data Sheet**. See 37 C.F.R. § 1.76.

7) ☐ **CD-ROM or CD-R in duplicate, large table or Computer Program  
(Appendix)**

8) ☐ **Nucleotide and/or Amino Acid Sequence Submission** (if applicable, all are  
necessary)

- a) ☐ Computer Readable Form (CRF)

- b) ☐ Specification Sequence Listing on:

- i) ☐ CD-ROM or CD-R (2 copies); or

- ii) ☐ Paper

- c) ☐ Statements verifying identity of above copies

B) ACCOMPANYING APPLICATION PARTS:

- 9) ☒ **Assignment Papers** (cover sheet & document(s))
- 10) ☐ **37 C.F.R. § 3.73(b) Statement** (when there is an assignee)
- 11) ☒ **Power of Attorney**
- 12) ☐ **English Translation Document** (if applicable)
- 13) ☒ **Information Disclosure Statement (IDS)/PTO-1449** (6 pp. total)
- 14) ☐ **Copies of IDS Citations**
- 15) ☒ **Preliminary Amendment** (11 pp. (includes marked-up copies))
- 16) ☒ **Return Receipt Postcard (MPEP 503)** (specifically itemized)
- 17) ☐ **Certified Copy of Priority Document(s)** (if foreign priority is claimed)
- 18) ☒ **OTHER:** (if applicable; specified below)

**Identification of Patent Under 37 CFR §1.607(c) (1 pg.)**

C) FOR CONTINUING APPLICATIONS: (the appropriate box is checked, and certain information is provided below and in a preliminary amendment)

☒ continuation                      ☐ divisional                      ☐ continuation-in-part (CIP)

of prior application no.: 09/874,514

filed: June 5, 2001

examiner: T. Solola

group/art unit: 1626

**for continuation or divisional applications only:** The entire disclosure of the prior application, from which an oath or declaration is supplied as detailed above, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference.



D.) PRIORITY CLAIM(S):

This application claims the benefit under 35 U.S.C. § 120 of any United States application(s) or PCT international application(s) designating the United States of America listed below:

<u>Application Serial No.</u>	<u>Filing date</u>	<u>Status (patented, pending, abandoned)</u>
09/874,514	June 5, 2001	Pending

This application claims the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

<u>Application Serial No.</u>	<u>Filing date</u>	<u>Status (pending, expired, abandoned)</u>
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E) METHOD OF PAYMENT OF FILING FEES FOR THIS APPLICATION:

- ☒ Applicant claims small entity status 37 C.F.R. § 1.27.
- ☒ A check is enclosed to cover the filing fees.
- ☒ The commissioner is hereby authorized to charge filing fees or to credit any overpayment to deposit account number 03-1721.

Basic Filing Fee (Small Entity)	\$370.00
Additional Fees:	
Total Number of Claims in excess of 20: (201- 20) x \$9	\$1,629.00
Number of Independent Claims in excess of 3:(25- 3) x \$42	\$924.00
Multiple Dependent Claims (\$140):	<u>\$140.00</u>
Total Filing Fee:	\$3,063.00

F) CORRESPONDENCE ADDRESS:



☒ Customer Bar Code Label: 24280

PATENT TRADEMARK OFFICE

☒ Correspondence Address:

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phone: (617) 248-5000  
fax: (617) 248-4000

Respectfully Submitted,

Karoline K.M. Shair, Ph.D.  
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